

REMARKS

Reconsideration of the Office Action mailed March 16, 2010 is respectfully requested.

Claim 17 has been amended to overcome the noted informality and withdrawal of the objection to that claim is requested.

Claim 1-7 and 9 have been rejected under 35 U.S.C. §112, second paragraph. Accordingly, claim 1 has been amended to provide a proper antecedent basis for the rotatable head. Therefore, withdrawal of this rejection is respectfully requested.

Independent claims 1 and 9 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kokobu et al., U.S. Patent No. 6,144,033 in view of the patent to Nishimoto, European Patent No. 1 504 881. Both of the machines described in Kokobu and Nishimoto are directed to applying a mark on a tire sidewall so as to show the heaviest or lightest point on the tire. This is clearly set out in Kokobu at column 2, lines 55-61 and in Nishimoto at column 5, lines 55-59 (paragraph 44). In distinct contrast, the printing system of the claimed invention is directed to placing a label on a tire tread surface as evidenced in Figs. 1 and 3 of the application. This is advantageous over the systems in the cited references because the tires can be stacked, which allows for faster overall movement of the tires through the manufacturing process, thus saving time and money.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Last, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectations of success must both be found in the prior art, and not based on the Applicant's disclosure. *In re Vaeck*, 947 F2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In regard to establishing a *prima facie* case of obviousness, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliably suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have

found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

It is respectfully submitted that not all of the independent claim limitations are met by the proffered combination. Kokobu supposedly teaches all the elements except for a computer to receive a tire's specific information. This difference is supposedly taught by the reference to Nishimoto. In the purported teachings of Kokobu, all of the elements of the frame are supposedly provided. In the present application the frame (22) includes a first guide (24), a second guide (32), and a third guide (42). Claims 1 and 15 now specifically require that each of the three guides move linearly along their respective axes and that an arm (54) is rotatable with respect to one of the axes. Although a rotating mechanism 8 is shown in Kokobu for meeting the second guide, this feature in Kokobu does not move linearly nor meet the limitation regarding "an arm rotatable with respect to one of the axes." It is submitted that nowhere are such features provided by Kokobu or in any other reference, or in any combination of references made of record.

A further patentable distinction is that the rotatable arm moves in such a way to apply the label to a tire tread surface in a stack of tires. Kokobu, Nishimoto nor Tomosado can be combined in any way to achieve such a result. Since a *prima facie* case of obviousness cannot be made, it is respectfully requested that the rejection of claims 1 and 15 be withdrawn. With it being the position of the Applicants that claims 1 and 15 are allowable, all claims depending therefrom are likewise believed to be allowable.

In regard to dependent claim 5, it is asserted that Tomosado, Japanese Publication No. 2003/221021, teaches an applicator to include an arm rotatably attached to the carriage, wherein the arm is rotatable between a pick up position and an application position. Reconsideration of the teachings of Tomosado is requested. Nowhere in the Office Action has any motivation or suggestion been provided as to why Kokobu or Nishimoto would look to Tomosado for any feature. Kokobu and Nishimoto already provide various ranges of applicator motion through a marking process and no reasoning is provided as to why one skilled in the art looking at either reference would then look to Tomosado, which only has a single range of motion. Moreover, the proffered combination still does not meet the limitation of a rotatable arm that linearly moves along the first, second and third axes so as to pick up a label from the printer with the rotatable arm and then move the rotatable arm along the axes so as to apply the label to a tire tread surface of the specific tire within the stack of tires. Furthermore, as seen in Figs. 2, 3 and 5 of Tomosado, the label is applied directly to a roller instead of to an arm linearly moving

through three axes of motion, picking up the label and then applying the label to the tire tread surface. Accordingly, the cited references do not meet all of the claim limitations. Finally, nothing in Tomosado, in combination with Kokobu and/or Nishimoto teaches or suggests applying a label to a tire tread in a stack of tires.

In view of the foregoing amendments and arguments presented herein, the Applicants believe that they have properly set forth the invention and accordingly, respectfully request the Examiner reconsider and withdraw the rejections provided in the last Office Action. A formal Notice of Allowance of claims 1-7, 9, and 15-17, is earnestly solicited.

In the event that a fee required for the filing of this document is missing or insufficient, the undersigned Attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication or to credit any overpayment to Deposit Account No. 18-0987. If a withdrawal is required from Deposit Account No. 18-0987, the undersigned Attorney respectfully requests that the Commissioner of Patents and Trademarks cite Attorney Docket Number **CTA.P0003** for billing purposes.

Should the Examiner deem a telephone call to be beneficial in resolving any remaining matters, or to place the claims in better form for allowance, the same would be greatly appreciated.

Respectfully submitted,



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